

Appl. No. 10/018,144
Amdt. Dated August 31, 2004
Reply to Office Action of June 2, 2004

REMARKS/ARGUMENTS

Claims 32 – 40 and 42 – 62 are pending in the application.

The present Office Action was made final by the Examiner. Applicants respectfully request withdrawal of such finality on the basis that the final rejection was premature and improper under MPEP section 706.07(a). In particular, Applicants respectfully submit that the Examiner has introduced a new ground of rejection that was not necessitated by Applicants' amendment of the claims, i.e., the claims were not "amended to require newly cited art" because the subject matter added to the independent claims was already the subject matter of an existing claim. As indicated on page 7 of Applicants' amendment dated January 26, 2004, Applicants merely incorporated the subject matter of previous claim 41 into the independent claims 32 and 51 to clarify when the movement of the first substrate past the pressure roller takes place. Since such subject matter was already contained in a claim that in turn was dependent on the independent claim into which it was incorporated, no subject matter was introduced that had not already been subject to a search. Had no amendment to claim 32 been made, the subject matter (of former claim 41) in question would have been searched further but no final rejection could have been issued. Combining the subject matter of claim 41 with claim 32 in no way changes that situation, and Applicants respectfully request withdrawal of the finality of the Office Action dated 06/02/2004.

The Examiner's attention is also respectfully directed to MPEP section 706.07, second paragraph, wherein it is stated that "the Applicant who is seeking to define his or her invention in claims that will give him or her the Patent protection to which he or she is justly entitled should receive the cooperation of the Examiner to

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that end, and not be prematurely cutoff from the prosecution of his or her application".

Nonetheless, with regard to the substantive rejection of the claims, the following comments are offered.

The Examiner has rejected apparatus claim 51 as being anticipated by JP '377. This reference discloses a method and an apparatus for coating one side of substrates, or for gluing together two substrates to form an optical data carrier.

For the one-sided coating of a substrate, the latter is initially placed upon an XY device 21. As the substrate lies upon this device 21, the substrate is conveyed below a nozzle 31 for the application of a liquid adhesive 31a. Subsequently, the substrate, with the liquid adhesive disposed thereon, is conveyed to a laminating station in which a protective film, such as a PMMA film 112, is laminated onto the substrate. This laminating process is apparently effected by moving the substrate, with the liquid adhesive disposed thereon, past a pressure roller 51.

The problem that results with the device of JP '377 is that the adhesive, which is to be glued with a protective film, is initially applied to the substrate in liquid form. With this type of application of the adhesive, however, there is the problem of a proper distribution of the adhesive upon the substrate, as well as the danger of incorporating air bubbles between the substrate and the adhesive, or between the adhesive and the protective layer or even within the adhesive.

Subsequently, the substrate that has been coated on one side in this manner can be glued to a further substrate, for example as illustrated in Fig. 14. In this connection, it should be noted that the laminated-on protective film 112 of the respective substrate faces outwardly. How an adhesive that is disposed between

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the substrates is applied to the respective substrate is not evident. However, from the type of adhesive one can assume that the adhesive is again applied in liquid form, and therefore the previously mentioned problems occur.

Thus, contrary to the Examiner's assertion, it is respectfully submitted that JP '377 does not show all of the features required by Applicants' apparatus claim 51. In particular, this reference does not teach or suggest a laminating station for applying, to a first substrate, an adhesive film that is adhesive on two sides. In JP '377, as can be clearly recognized in Fig. 5, the adhesive is applied in liquid form. The laminating station illustrated in Fig. 5 serves merely for laminating a protective layer onto the liquid adhesive layer. In this connection, there can result with JP '377 a further problem that during this laminating step, liquid adhesive will be pressed out over the edge of the substrate, since the protective foil is to be pressed against the substrate with pressure, and, as previously mentioned, at this point in time the adhesive is in liquid form. Furthermore, it is not clear from JP '377 how the laminating station functions, and whether during the laminating process the substrate is moved, by a device, past a pressure roller and is moved parallel to the surface of the substrate, all as required by Applicants' claim 51.

Finally, although JP '377 discloses a device for joining substrates together, this is independent from the laminating station, since in the laminating station no double-sided adhesive film is applied.

In contrast with JP '377, claim 51 of the present application requires a laminating station in which an adhesive film, that is adhesive on two sides, is applied to a first substrate in a specific manner, whereby the first substrate is subsequently aligned and joined with a second substrate in a substrate adhering station, whereby

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station, whereby it is clear to one of ordinary skill in the art that in this case the double-sided adhesive film must previously be applied to the first substrate in order to join the two substrates together. It should furthermore be noted that although JP '377 discloses a joining together of two substrates, it is not evident how or in what type of station such a joining together takes place, and even if an alignment of the substrates relative to one another were to be possible, this cannot be recognized in Fig. 14 of the reference.

In view of the foregoing, it is respectfully submitted that JP '377 is not a proper reference under either MPEP section 2131 or section 2143.03, since the reference does not teach or suggest every element of the claim.

With regard to the method claims, the Examiner has rejected claim 32 under 35 USC 103(a) over Amo in view of JP '377. The distinctions between the present invention and the Amo reference were discussed in detail in Applicants' amendment dated January 26, 2004, especially with regard to the fact that Amo does not teach moving the substrate during lamination. The Examiner then cites JP '377 for a movement of a substrate along a pressure roller during lamination. However, as discussed above, this does not involve a laminating process for the application of an adhesive film that is adhesive on two sides and that is subjected to certain limitations. Rather, JP '377 discloses the lamination of a foil or film onto a data carrier that is coated with a liquid adhesive. It is respectfully submitted that one of ordinary skill in the art would understand that the laminating system of Amo, which has a very special design, could not be replaced by a laminating system as disclosed in JP '377, in order to move a substrate past a pressure roller during a laminating process.

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It is furthermore respectfully submitted that Amo and JP '377 relate to entirely different systems, namely on the one hand a coating or joining together of substrates via a liquid adhesive, as in JP '377, and the laminating-on of an adhesive film as in Amo. Furthermore, it is respectfully submitted that a combination of these two references would in no way be obvious to one of ordinary skill in the art. In particular, there is no suggestion or motivation to modify or combine the reference teachings in the manner suggested by the Examiner. For example, one of ordinary skill in the art would have to adapt a laminating station, which is designed for laminating a protective film onto a substrate that is coated with liquid adhesive, in such a way that a substrate that is not provided with adhesive would now be laminated with an adhesive film that is adhesive on two sides, as required by Applicants' claim 32.

It is respectfully submitted that since the prior art does not suggest the desirability of the claimed invention, such art cannot establish a prima facie case of obviousness as clearly set forth in MPEP section 2143.01. Please note also that the modification proposed by the Examiner would change the principle of operation of the prior art, so that also for this reason the references are not sufficient to render the claims prima facie obvious (see the last paragraph of the aforementioned MPEP section 2143.01).

In view of the foregoing discussion, Applicants' respectfully request reconsideration of the allowability of pending claims 32 – 40 and 42 – 62. Furthermore, should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call from her in order to be able

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to discuss any outstanding issues and to expedite placement of the application into
condition for allowance.

Respectfully submitted,



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